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09393210

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09393210	08/26/99	HUBER	11-245542

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EXAMINER CHERVINSKY, B

ART UNIT 2225	PAPER NUMBER
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DATE MAILED: 09/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/383,210

Applicant(s)

HUBER ET AL.

Examiner

Boris L. Chervinsky

Art Unit

2835

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on 26 August 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☒ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8, as best understood, is an independent claim, but has improper reference to claim 1, which makes scope of the claim indefinite.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1, 2, 5, 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Daszkowski.

4. Daszkowski discloses a thermally conductive mat Fig. 4-7 having a sheet-like geometry, an underside of the mat is intended to be in contact with an outer wall of an appliance and a top side to be in contact with a heat generating device 34, the mat is

comprised of a silicone elastomer or any elastomeric material (col. 6, lines 25-31), as claimed in claim 2 and its top side having a height-compensating structure of raised lamellae as claimed in claims 5 and 6.

5. Claims 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al.

Smith et al. discloses the housing 12 comprising wall parts, the circuit board 26 with electrical component 30 mounted on its surface and thermal mat 40 having thermally conductive adhesive layer 48, as claimed in claim 10, mounted between the circuit board and the wall part

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daszkowski.

Regarding to claim 4, Daszkowski discloses the claimed invention but does not specify thickness to be at least 1 mm. It would have been an obvious matter of design choice to have thickness of the mat 1 mm. or more, since such a modification would have involved a mere change in the size of a component. A change in size is generally

recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding to claim 7, Daszkowski discloses the claimed invention except a sticky surface. It would have been an obvious matter of design choice to have a sticky surface for convenient attachment of the mat to another surface since such sticky surfaces are known and widely used in the industry.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al.

Smith et al. discloses the claimed invention, as applied to claim 8 above, but does not have the housing made of metal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the housing of metal since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Snyder et al., Pat. 3,694,699; Thomas, Pat. 4,782,893; Schneider, Pat. 5,796,049; Kitagawa, Pat. 5,821,612 and Freuler et al., Pat. 5,912,805 disclose heat conductive thermal sheet-like structures for mounting heat generating electronic components.

Application/Control Number: 09/383,210
Art Unit: 2835

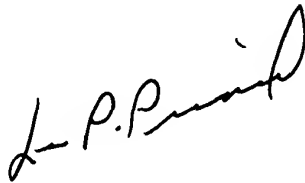
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris L. Chervinsky whose telephone number is 703-308-5429. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P. Picard can be reached on 703-308-0538. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7724 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0658.

BC
September 20, 2000



Leo P. Picard
Supervisory Patent Examiner
Technology Center 2800